

## **REMARKS**

### **1. Status of the Claims**

Claims 1-14 stand pending. Claims 1-14 are subject to the Restriction/Election Requirement.

Applicants newly introduce claim 15 as a generic claim to recite the claimed process. Support for the newly introduced claim 15 can be found at least, for example, from paragraph [0009] on page 3, Example 1 on page 15, and Example 2 on page 16 of the Specification, as well as the originally filed claims. In addition, Applicants amend claims 1-3 and 5-7 to more precisely describe the claimed subject matter. Support of the amendment can be found at least, for example, from the originally filed claims. Accordingly, no prohibited new matter has been introduced by entry of the claims.

### **2. Acknowledgment of Priority**

Applicants note with appreciation the indication that the certified priority documents have been received.

### **3. Information Disclosure Statements**

Applicants respectfully request acknowledgment of the Information Disclosure Statement provided March 14, 2008.

### **4. Species Election Requirement**

The Office alleges that the present claims are directed to more than one species of the generic invention. Office Action at page 2. Specifically, the Office alleges that these species are not so linked as to form a single general invention concept under PCT Rule 13.1, and thus lack unity of invention. The Office requires the election of one of the following two species:

- 1) the compound of formula (1); and
- 2) the compound of formula (4).

5. **Election with Traverse**

Applicants elect **species 1 (i.e., the compound of formula (1)) with traverse**. Claims 1, 3-8, 10, 12-13, and 15 encompass the elected species. Among them, ***claim 15 is the generic claim, as well as its dependent claims 3-7 and 12.***

Applicants respectfully traverse the species election requirement. Restriction is proper only if the inventions are independent or distinct as claimed ***and*** there would be a serious burden on the Office if restriction were not required. *See* M.P.E.P. §§ 803, 808; *see also* M.P.E.P. § 808.02 (establishing burden). The Office has evinced no burden to search the two indicated species. Additionally, the Office cannot properly support its position of burden, when the ISA ***already has searched*** all the claimed subject matter. Moreover, it is well established that each restriction and election requirements must be considered on its own merits. *See Id.* and M.P.E.P. § 1850. In the present case, rather than consider the merits of the case, the Office provides no justification relating to burden of search.

Additionally, M.P.E.P. § 803.02 requires the Office to examine ***all*** claimed species when they “are sufficiently few in number . . . such that a search and examination of the entire claim can be made without serious burden.” In this case, the number of species in the various categories identified by the Office numbers two. The Office does not justify why searching two species possesses such a serious burden of search.

Applicants note further that the species are recited in dependent claims as amended. M.P.E.P. § 806.04(f) states “to require restriction between claims limited to species, the claims must not overlap in scope.” At the very least, M.P.E.P. § 806.04(f) requires the Office to justify why claims issuing on the allegedly separate and distinct species would not overlap in scope. *See also* M.P.E.P. § 806.05 (“Related inventions in the same statutory class are . . . not overlapping in scope, if a first invention would not infringe a second invention, and the second invention would not infringe the first invention.”). The Office is silent in this regard in the instant case.

The Office appears to use a procedural tool designed to reduce its own administrative burdens as a surrogate to avoid substantive examination of the subject matter that Applicants consider the invention. The Office does not reduce its own administrative burden properly by

shifting onto Applicants the costs of prosecuting multiple applications directed to overlapping subject matter. The Court of Customs and Patent Appeals held more than thirty years ago that such a policy contravenes Applicants' statutory right under 35 U.S.C. § 112, second paragraph, to present "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." *See In re Weber*, 580 F.2d 455, 458, 198 U.S.P.Q. 328, 331 (C.C.P.A. 1978).

For all the reasons above, the species election is improper and should be withdrawn in its entirety.

### CONCLUSION

Should the Office have any questions or comments regarding Applicants' amendments or response, please contact Applicants' undersigned representative at (202) 842-8821. Furthermore, please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully Submitted,

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